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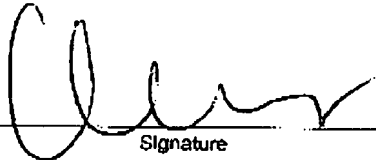
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 77682-111	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR		Application Number 09/466,124	Filed December 21, 1999
on _____		First Named Inventor BRISEBOIS, Mitch A.	
Signature _____		Art Unit 2616	Examiner HOM, Shick C.
Typed or printed name _____			
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the			
<input type="checkbox"/> applicant/inventor.		Signature	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		_____ Elliott S. SIMCOE Typed or printed name	
<input checked="" type="checkbox"/> attorney or agent of record. Registration number 50,010		_____ 613-232-2486 Telephone number	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		_____ October 30, 2007 Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/466,124 Confirmation No. 9802
Applicant : BRISEBOIS, Mitch A. et al.
Filed : December 21, 1999
TC/A.U. : 2616
Examiner : HOM, Shick C.

Docket No. : 77682-111
Customer No. : 07380

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OCT 30 2007

Commissioner for Patents
Alexandria, VA 22313-1450
U.S.A.

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests review of the final rejections issued in connection with the above-identified application on August 30, 2007.

Claims 1 to 3, 5, 6, 8 to 12, 21 to 23, 28, 30, 31, 36 to 48, 50, 51 and 53 to 55 stand rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 6,115,613 to Jonsson in view of United States Patent No. 6,032,051 to Hall et al. Claims 30 and 31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Jonsson in view of Hall et al. and further in view of United States Patent No. 6,549,768 to Fraccaroli and United States Patent No. 6,249,584 to Hämäläinen et al., respectively.

Applicant respectfully submits that there are clear errors in the above rejections, and that the Examiner has failed to satisfy the requirements for a finding of obviousness recently articulated by the U.S. Supreme Court in its decision in *KSR Int'l v. Teleflex, Inc.*, No. 04-1350, slip op. at 14 (U.S., Apr. 30, 2007). Accordingly, as a matter of law, the rejection of the claims cannot stand and must be rescinded.

Law

The United States Supreme Court visited the manner by which "obviousness" under 35 U.S.C. §103 is to be interpreted in the case of *KSR Int'l v. Teleflex, Inc.*, No. 04-1350, slip op. at 14 (U.S., Apr. 30, 2007). As the Court noted in KSR, once the scope of the prior art is ascertained, the content of the prior art must be properly combined. An obviousness inquiry

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requires review of a number of factors, including the background knowledge possessed by a person having ordinary skill in the art, to determine whether there was an apparent reason to combine the elements of the prior art in the fashion claimed by the present invention. For the Patent Office to properly combine references in support of an obviousness rejection, the Patent Office must identify a reason why a person of ordinary skill in the art would have sought to combine the respective teachings of the applied references. Id. at 15. Even if the Patent Office is able to articulate and support a suggestion to combine the references, it is impermissible to pick and choose elements from the prior art while using the application as a template. *In re Fine*, 837 F.3d 1071 (Fed. Cir. 1988). It is respectfully submitted that the 35 U.S.C. §103(a) rejection is deficient for its failure to comply with the U.S. Supreme Court's requirements recently articulated in *KSR*.

Prima Facie Obviousness Threshold

MPEP 2142 explains the procedural tool of the *prima facie* obviousness threshold, i.e. the applicant does not bear the burden of addressing substantive issues of obviousness (such as secondary considerations) until the examiner makes the *prima facie* case. A *prima facie* case requires (1) the all elements be taught in the cited reference or references when combined; (2) reasonable expectation of success; and (3) motivation to combine the cited references. 1 and 2 remain irrespective of *KSR*. The May 3, 2007 memo from Margaret Focarino dealing with the *KSR* decision states that (3) remains a requirement. More specifically, *KSR* requires that there be a reason why a person of ordinary skill in the art would have combined the references, and the Focarino memo requires the Examiner to provide such a reason during prosecution.

With reference to the Examiner's rejection of claims 1 to 3, 5, 6, 8 to 12, 21 to 23, 28, 30, 31, 36 to 48, 50, 51 and 53 to 55 under 35 U.S.C. § 103(a) based on the combination of Jonsson and Hall, it is respectfully submitted that the first requirement for establishing a *prima facie* case of obviousness cannot be established. That is, the cited references do not teach all of the claimed limitations. Specifically, no combination of Jonsson and Hall teaches or even suggests "means for determining if a first mobile station sending a data unit and a second mobile station scheduled to receive the data unit are both members of the private network group; and means for enabling communication of the data unit from the first mobile station to the second mobile station through the respective maintained communication links of the first mobile station and the second mobile

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station only if they are both members of the private network group", as recited in independent claim 1, and as recited in the corresponding limitations of independent claims 11, 12, 22, 28, 36, 40, 44 and 45.

Jonsson teaches a system and method for providing mobile radio telephone service to a plurality of members of a subscriber group. The subscription limits the number of communication channels that the subscription group has access to at a given time, allowing the network operator to spread subscriber traffic over a larger period of time.

There is no indication in Jonsson that calls between group members are handled differently than calls between members of different groups. Moreover, ingoing and outgoing calls are processed at a service node 101, with which the mobile stations **do not maintain communication links**. The private automatic branch exchange (PABX) 102 routes call attempts through the service node 101, which determines if the call attempts are completed. Furthermore, while Jonsson may disclose embodiments in which the identity or subscription group/identity of a mobile station that initiates a call is determined (see column 3, lines 10-27), and embodiments in which the identity or subscription group/identity of a mobile station that is to receive a call is determined (see column 3, lines 28-41), Jonsson does not teach an apparatus that maintains communication links with a plurality of mobile stations, and that includes "means for determining if a first mobile station sending a data unit and a second mobile station scheduled to receive the data unit are both members of the private network group", as recited in independent claim 1.

With reference to Hall, the Examiner has asserted that Hall discloses "means for enabling communication of a data unit from a first mobile station to a second mobile station through respective maintained communication links of the first mobile station and the second mobile station only if they are both members of a private network group". However, it is respectfully submitted that Hall fails to disclose this particular feature, as established below.

Hall teaches wireless mobile communication devices and a home location register (HLR) that automatically transmit therebetween information regarding the status of the devices. The information can either be transmitted directly between the devices using the standard communication channels of a wireless network, or through the HLR. A plurality of mobile devices can be listed as a group and the status checks/updates can be limited to devices that are

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part of the group. When the status information is shared directly between the devices, the status information and the group membership information is stored on the devices. When the status information is shared via the HLR, the status information and the group membership information is stored on the HLR as a master source and the devices check/update status information from/to the HLR.

The Examiner has pointed to Column 6, lines 48-53 of Hall in support of the assertion that Hall discloses "means for enabling communication of a data unit from a first mobile station to a second mobile station through respective maintained communication links of the first mobile station and the second mobile station only if they are both members of a private network group". However, this portion of Hall merely states that "[t]he group select input of FIG. 3 is a user input that selects which group is to be monitored. Moreover, the group select input can designate the selected group as a closed user group so that the device 31, while the closed user group designation is active, communicates to and receives communication from only the group members in the selected group". It is noted that this particular feature of Hall is **limited to only the embodiment that involves direct communication between devices**. The group select input is individual to the user, i.e., it is not a universal choice, and the individual device user can define his own group on his device, which does not have maintained communication links with other devices. This is quite different from the present invention, in which the apparatus has maintained communication links with each of the mobile stations and determines if data is to be communicated between the mobile stations based on whether or not they are part of the same private network.

The embodiments in which status information is shared directly between devices is **not applicable to the present invention**, as the apparatus that limits status updates/checks to group members is present on each of the devices, i.e., each device determines if the mobile station that is attempting to check/update its status is authorized to do so. **Therefore, there are no maintained communication links between the apparatus and the devices, as each device does not maintain communication links with each of the other devices.**

In view of the foregoing, it is respectfully submitted that no combination of Jonsson and Hall would allow one skilled in the art to arrive at the present invention, as Jonsson and Hall, both alone and in combination, fail to teach key limitations of the independent claims.

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Furthermore, it is also submitted that the Examiner has failed to even provide a satisfactory reason for combining the references, even if it is assumed that the references disclose the limitations that the Examiner alleges that they do, which Applicant contends they do not. In particular, the Examiner states that the reason one skilled in the art would add the teachings of Hall to those of Jonsson, is because doing so allegedly "provides more efficiency for the system design since the design uses the known means and method of providing HLR for verifying membership and it also provides the desirable added feature of restricting communication only to group members of the private network group in the system" (page 12 of the Office Action). It is respectfully submitted that this is not an adequate reason to combine the references. It is also respectfully submitted that the Examiner has applied hindsight analysis and has attempted to justify the combination of the references through broad conclusory statements that do not provide a satisfactory reason to combine the references in the claimed manner.

Turning now to the Examiner's rejection of dependent claims 30 and 31 under 35 U.S.C. § 103(a) as being obvious to a person skilled in the art having regard to Jonsson in view of Hall and further in view of either Fraccaroli or Hämäläinen, respectively, it is respectfully submitted that both Fraccaroli and Hämäläinen fail to overcome the deficiencies of Jonsson and Hall noted above, and therefore claims 30 and 31 are both novel and inventive over the cited references for at least the same reasons as the independent claims from which they depend.

In view of the foregoing, Applicant submits that the rejection of the claims is clearly in error and should be withdrawn.

Claims 1-55 are believed to be allowable over Jonsson, Hall, Fraccaroli and Hämäläinen, and early action to this end is respectfully requested.

Respectfully submitted,
BRISEBOIS, MITCH A. ET AL.

By


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Date: October 30, 2007

ESS:JFS:sng